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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,878	11/24/2003	Eric Lawrence Barsness	ROC919990144US2	5134

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IBM Corporation, Dept. 917
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EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

MAIL DATE	DELIVERY MODE
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06/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,878

Applicant(s)

BARSNESS, ERIC LAWRENCE

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20031124</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

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1. Claims 1-17 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The first page of the specification needs to be updated to indicate that the United States Patent Application listed on that page is now Abandoned.
4. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

- a) "said outgoing message"--claim 7 (line 4), claim 14 (line 4), and claim 17 (line 4);
- b) "said first user"—claim 15 (line 15 and twice on last line);
- c) "said reporting availability"—claim 4 (line 2) and claim 11 (line 2).

7. As to 6 (a, b, and c) above, these are but a few examples of numerous cases where clear antecedent basis are lacking and not an exhausting recital. Any other term(s) or phrase(s) overlooked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent basis also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent basis for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent basis are lacking can be viewed as non-responsive. Nonetheless, should a response yield all claims allowable short *a few* cases where clear antecedent basis are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following

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statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent basis are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of allowance by the applicant.

8. Claim 1 recites first computer without a second computer, same with "first user". Thus it cannot be clearly ascertained if there is within the scope of the claimed invention a "second computer" and/or a "second user". Same for "a first user" in claim 8.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

10. **Claims 1-17 are rejected under 35 U.S.C. 102 (e)** as being anticipated by (United States Patent Number: US 6,807,423 B1).

11. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

12. Per claim 1, Armstrong taught an instant messaging (e.g., see col. 2 (lines 11-29) and col. 3 (line 38-et seq.)) computer program product operating in a first computer system attached to a network of computer systems (e.g., see figure 2 (Internet)), said computer program product including a plurality of processor executable instructions recorded on signal-bearing media, wherein said instructions comprise:

a) an incoming message function (e.g., see Abstract, col. 2 (lines 11-29), col. 3 (line 38-et seq.)) col. 17 (lines 49-67), and col. 7 (line 9-et seq.)), said incoming message function receiving incoming instant messages from users of other computer systems attached to said network, said

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other computer systems attached to said network executing respective instant messaging applications, said incoming message function further informing a first user of said first computer system of receipt of said incoming instant messages (e.g., see col. 12 (line 53-et seq.) and col. 17 (line 26-et seq.));

b) an outgoing message function (e.g., col. 2 (lines 11-29) and col. 3 (line 38-et seq.), and col. 7 (line 9-et seq.)), said outgoing message function sending instant messages to said respective instant messaging applications executing in said other computer systems attached to said network (e.g., see col. 12 (line 53-et seq.) and col. 17 (line 26-et seq.)); and

c) an availability reporting function, said availability reporting function reporting availability status of said first user to one or more said respective instant messaging applications executing in said other computer systems attached to said network, wherein said availability reporting function automatically infers whether said first user is available by accessing calendar data concerning said first user (e.g., see col. 4 (line 11-et seq.), col. 10 (line 57-et seq.)).

13. In summary, Armstrong taught an instant messaging system with messages that were incoming messages and outgoing messages and in which there was also provided an availability status inferred of a user, sent to others, based on calendar data and other claimed activities.

14. Per claim 2, Armstrong also taught wherein said availability reporting function further automatically infers whether said first user is available from at least one indicium of availability from the set consisting of: (a) whether the first computer has received any input from the first user within a predetermined time period; and (b) whether the first computer is in a locked state (e.g., see col. 14 (line 60-et seq.)).

15. Per claim 3, claim 4, claim 5, and claim 6, Armstrong also taught the availability reporting function accesses calendar data by calling a calendar application to access data stored in at least one calendar data file having normal hours of availability and non-availability and other triggering events such as a PALM TOP being open or closed (and thus not locked) (e.g., see figure 9 (804), col. 4 (line 11-et seq.), and col. 10 (line 57-et seq.)) and thus a reason for inferring unavailability.

16. Per claim 7, Armstrong's figure 2 showed the network as an Internet where incoming messages and outgoing messages were received from and sent to internet servers (ISP).

17. Per claims 8-17, these mirroring claims do not teach or defined above the correspondingly rejected claims given above by extending them to a method and/or system, and are thus rejected for the same reasons given above.

18. **A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).**

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (571) 273-8300.

21. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

A handwritten signature in black ink, appearing to read 'R. B. Harrell', with a long horizontal line extending to the right.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142